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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/788,542 02/27/2004 Frederic Scheer 112843-63 7084

24573 7590 01/25/2008
BELL, BOYD & LLOYD, LLP
P.O. Box 1135
CHICAGO, IL 60690

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| EXAMINER |
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CHEN, VIVIAN

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| ART UNIT | PAPER NUMBER |
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1794

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| MAIL DATE | DELIVERY MODE |
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01/25/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/788,542 | Applicant(s) SCHEER ET AL. | |
| | Examiner Vivian Chen | Art Unit 1794 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6,11,12,14-16 and 18-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-6,11,12,14-16 and 18-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Claims 3, 7-10, 13, 17, 28-30 have been cancelled by Applicant.

Specification

2. The amendment filed 1/24/2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the newly added claim limitation in claim 25 reciting an organic acid content of up to and including 5% by weight.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

3. Claim 25 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention for the reasons stated above in the objection to the amendment filed 1/24/2007 under 35 U.S.C. 132(a). The disclosure as originally filed fails to provide support for the required presence of organic acids and only provides support for the presence of organic peroxides.

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4. Claims 1-2, 4-6, 11-12, 14-16, 18-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1, 11, 21, 23, 25, 26, the phrase "co-polyester polymer with adipic acid" is vague and indefinite because it is unclear whether the phrase actually refers to: (1) a two component blend/mixture with a copolyester resin as the first component (in unspecified proportions) and adipic acid as the second distinct component (again, in unspecified proportions); or (2) a single copolyester resin wherein the copolyester itself contains chain units *derived* from adipic acid. The Examiner notes that Applicant's own disclosure discusses the use of adipic acid as a separate and individual component in the biodegradable composition (lines 1-7 on page 8 of the Specification).

Claim Rejections - 35 USC § 103

5. The rejections under 35 U.S.C. 103(a) based on CHEN ET AL (US 5,756,651) or JP '658 have been withdrawn in view of Applicant's Amendment filed 11/1/2007.

Response to Arguments

6. Applicant's arguments filed 11/1/2007 have been fully considered but they are not persuasive.

(A) Applicant argues that claim 25 recites the presence of an organic peroxide which is supported in the disclosure as originally filed. However, contrary to Applicant's assertions, present claim 25 does not contain the language "organic peroxide", but rather clearly specifies

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the presence of "an organic acid in an amount between 0.1 and 4.5% by weight" (emphasis added) (lines 9-10 of claim 25, as presented in the Amendment filed 11/1/2007). The presence of an organic acid is not supported in the disclosure as originally filed and thereby constitutes new matter, since the term "organic acid" and "organic peroxide" do not refer to the exact same group of compounds and therefore are not freely interchangeable.

7. Applicant's arguments filed 11/1/2007 have been fully considered but they are not persuasive. Applicant's arguments with respect to CHEN ET AL '651 and GRUBER ET AL '095 and MOHANTY have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (571) 272-1506. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano, can be reached on (571) 272-198. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

The General Information telephone number for Technology Center 1700 is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

January 18, 2008



Vivian Chen
Primary Examiner
Art Unit 1794